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GROUP 1700

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30205/38083

1752

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Geun Su Lee et al.
Serial No.: 10/054,532
Filed: January 22, 2002
For: Photoresist Monomers, Polymers
Thereof and Photoresist Compositions
Containing the Same
Group Art Unit: 1752
Examiner: Yvette C. Thornton

I hereby certify that this paper and the documents referred to as enclosed therewith are being deposited with the United States Postal Service as first class mail, postage prepaid, on August 28, 2003, in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450

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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

In response to the restriction requirement imposed in the office action mailed on August 1, 2003, applicants elect Group I, claims 1-7 and 16-21 *with traverse*. Applicants respectfully submit that the restriction requirement is improper for the following reasons.

The office action identifies four separate groups of inventions. Group I, claims 1-7 and 16-21 are drawn to a photoresist monomer, photoresist polymer and photoresist composition. Group II, claims 8-15, is drawing toward a method of making a photoresist polymer, but the photoresist polymer is the same as the photoresist polymer of claims 2-7 it includes the photoresist monomer of claim 1. Group III, claims 22-27, is directed toward a method of making a photoresist pattern, but is limited to use of the photoresist composition of claim 16. Group IV, claim 28, is directed toward a semiconductor element made in accordance with the process of claim 22. Thus, all groups of claims are inextricably linked by either claim limitations or direct reference to claims of the other groups. Groups II-IV are so

closely related to Group I that a proper search of Group I would inevitably cover Groups II-IV.

The M.P.E.P. clearly and unequivocally states that there are two criteria which must be met for a requirement for restriction to be proper; (1) the inventions must be independent or distinct as claimed; and, (2) there must be a serious burden on the examiner if restriction is not required. (M.P.E.P. § 803). In this instance, although the Office action argues that the groups of claims identified in the Office action are patentably distinct, it fails to demonstrate that a serious burden would be placed on the Examiner if election were not required. Indeed, the Office action admits that the two groups (Groups I and III) fall within the same class; albeit different subclasses. Given this close classification, applicant respectfully submits that there can be no serious burden upon the Examiner in reviewing all of the claims simultaneously.

Moreover, the applicant notes that if there is a serious burden in the present application, it is on the applicant's assignee as a result of this restriction requirement. Unless the restriction requirement is withdrawn, the applicant's assignee must not only prosecute separate applications, which multiplies the cost of obtaining protection for the inventive subject matter, but it must also then pay separate maintenance fees for each of the issued patents. It is respectfully submitted that the burden of the expense incurred in order to obtain two different patents and the further expense in maintaining those patents suffered by the taxpayer, far outweigh any possible burden the Patent Office may incur as a result of simultaneously examining the claims of this application.

In summary, the Office action fails to address the second required criteria for restriction set forth in the M.P.E.P. In view of the following mandate, this failure renders the restriction requirement improper:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

(M.P.E.P. § 803)(emphasis added). Therefore, applicant requests that the requirement for restriction be withdrawn. Moreover, because the restriction requirement is incomplete for failing to address the second requirement specified in the M.P.E.P., the applicant has not been afforded a fair opportunity to respond and the restriction requirement cannot properly be made "Final."

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An early action on the merits of all groups of claims is earnestly solicited.

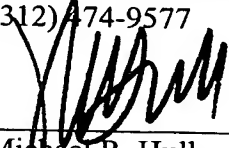
The Commissioner is authorized to charge any fee deficiency required by this paper, or credit any overpayment, to Deposit Account No. 13-2855.

Respectfully submitted,

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August 28, 2003

By:



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